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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

CHAKRABARTI, ARUN K

ART UNIT PAPER NUMBER

1634

DATE MAILED: 02/28/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/531,120

Applicant(s)

Preuss

Examiner

Arun Chakrabarti

Art Unit

1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Jan 16, 2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 128-146 is/are pending in the application.

4a) Of the above, claim(s) is/are withdrawn from consideration.

5) ☐ Claim(s) is/are allowed.

6) ☒ Claim(s) 128-140, 142, and 144-146 is/are rejected.

7) ☒ Claim(s) 141 and 143 is/are objected to.

8) ☐ Claims are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. .
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). .

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s), 11, 11

20) ☐ Other:

Art Unit: 1634

DETAILED ACTION

Election/Restriction

1. Applicant's election of Group VI corresponding to claims 128-146, without traverse, in paper number 17 is hereby acknowledged.

Specification

2. Claim 143 is objected to because of the following informalities: Claim 143 is dependent on itself. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 128-140, 142, and 144-146 are rejected under 35 U.S.C. 102 (b) as being anticipated by Richards et al. (U.S. Patent 5,270,201) (December 14, 1993).

Richards et al. teach a plant comprising a cell transformed with a recombinant DNA construct comprising a plant centromere (Abstract, Column 6, lines 5-31, Claim 25).

Richards et al. teach a method of preparing a transgenic plant cell comprising contacting a starting plant cell with a recombinant DNA construct comprising a plant centromere, whereby the

Art Unit:

starting plant cell is transformed with the recombinant DNA construct (Abstract, Column 6, lines 5-31, Claim 25).

Richards et al. teach a method, wherein the recombinant DNA construct comprises a second structural gene (Figures 7-8, and 10 and Claims 1-5).

Richards et al. teach a method, wherein the plant centromere is an *Arabidopsis thaliana* centromere and the starting plant cell is an *Arabidopsis thaliana* cell (Abstract, Column 6, lines 5-31, Claim 25).

Richards et al inherently teach a transgenic plant comprising a minichromosome vector, wherein the vector comprises a plant centromere and a telomere sequence, a structural gene, a second telomere sequence, and an autonomous replicating sequence (Abstract, Column 6, lines 5-31, Claim 25 and Figures 7-8, Column 16, lines 1-47, Example 18, and Claims 1-5).

Richards et al inherently teach a transgenic plant, wherein the structural gene is selected from a toxin gene or nitrogen fixing gene or hormone gene or antibiotic resistance gene (Column 1, lines 19-34 and Column 18, lines 30-55).

Richards et al inherently teach and suggest a transgenic plant can be made as dicotyledonous plant and monocotyledonous plant's such as maize's genomic DNA cross hybridize with telomeric repeats (comprising centromere) from *Arabidopsis thaliana*.

Art Unit:

Allowable Subject Matter

5. Claim 141 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


ARUN K. CHAKRABARTI
PATENT EXAMINER

Arun Chakrabarti,

Patent Examiner,

February 21, 2002